

REMARKS

**I. Introduction**

By this paper, claims 1-8 are canceled and claims 9-24 are added. Claims 9-24 will be pending in the application upon entry of this amendment. Applicants make the following remarks in response to the Office action dated December 14, 2004, and respectfully request favorable consideration of pending claims 9-24.

The Background of the Invention section of the application has been amended to clarify the disclosure of U.S. Pat. No. 5,342,049 (Wichinsky et al.). No new matter is added.

Applicants request a one month extension of time up to and including April 14, 2005, for filing a response to the Office action dated December 14, 2004. A check in payment of the extension is included with this paper.

**II. Change in Power of Attorney and Correspondence Address**

\* Enclosed are forms cancelling all previous powers of attorney in the above-noted application and appointing the attorneys/agents associated with Customer Number 000321 with full power of substitution, revocation, and addition, to prosecute this application in the Patent and Trademark Office. Please enter the change into the record for this application.

Please direct all correspondence to Customer Number 000321.

**III. Inventorship of Claimed Invention**

In consideration of the Examiner's comments in paragraph 2 on page 2 of the Office action, Applicants submit that the subject matter of new claims 9-24 was commonly owned as of its date of invention.

#### IV. Applicants' Disclosed Gaming Apparatus

Applicants have invented a unique gaming apparatus for interactive play by a player. The apparatus includes a random play feature and a skill play feature. Specifically, it includes a slot machine (random play feature) and a pinball machine (skill play feature) where play on the pinball machine may be distinct from play on the slot machine. Play may be initiated on either the slot machine or the pinball machine, but as described in the disclosed embodiment, is desired to begin on the slot machine and then switched between the slot machine and pinball machine under certain conditions. The goal of playing the slot machine is to achieve winning combinations of symbols to receive credits or prizes (e.g., jackpot prizes). But achieving a winning combination is a somewhat random event and is completely controlled by the slot machine. The goal of playing the pinball machine is to move a pinball around a playing area to hit certain targets/sensors and accumulate credits. The number of credits accumulated is controlled substantially by the player and his/her pinball skill.

In one aspect of the gaming apparatus, play switches from the slot machine to the pinball machine upon the occurrence of a predetermined condition. In particular, play switches when a predetermined combination of slot machine symbols is displayed. This predetermined combination, however, is not one of the slot machine's winning combinations described above. Instead, it is a special combination that includes a pinball symbol, and it only switches play from the slot machine to the pinball machine. Achieving the special combination may not reward the player with credits or prizes, and gives the player only an opportunity to play the pinball machine.

In another aspect of the apparatus, the pinball machine may comprise traditional pinball machine components, including flippers, a pinball, and a playing area. The flippers are used by the player to interactively move the pinball around the

playing area. Play switches from the pinball machine to the slot machine, for example, when the player loses the pinball from the playing area.

In still another aspect of the apparatus, the slot machine may include a slot arm, which not only initiates movement of symbols of the slot machine but also operates a pinball game of the pinball machine.

**V. Response to Rejection of Claims 1-8 Under 35 U.S.C. § 103**

Claims 1-8 stand rejected under 35 U.S.C. § 103 in view of U.S. Pat. No. 5,342,049 (Wichinsky et al., hereinafter "Wichinsky"). Claims 1-8 are canceled by this paper and their rejections are considered moot.

**VI. Comments Regarding New Claims 9-24**

**A. Claims 9-17**

New claim 9 is directed toward a gaming apparatus operable by a player and having a slot mode and a pinball mode. The apparatus comprises:

- (a) a slot machine capable of being activated by a player in the slot mode of the apparatus to display different combinations of symbols, the symbols including a pinball symbol;
- (b) a pinball machine operable in the pinball mode for the player to play a pinball game;
- (c) at least one of the combinations of symbols including the pinball symbol, the apparatus switching from the slot mode to the pinball mode upon display of said one combination by the slot machine.

Applicants do not believe the references of record, including Wichinsky, show or suggest every feature of new claim 9. For example, none show or suggest a gaming apparatus comprising a slot machine and a pinball machine where operation switches from the slot machine to the pinball machine when a predetermined combination of slot machine symbols, of which one

is a pinball symbol, is displayed. Wichinsky is representative of the references of record and discloses a gaming machine combining a slot machine and a pinball-type machine where play switches from the slot machine to the pinball-type machine after each and every play of the slot machine, regardless of whether a special combination of symbols is achieved. In addition, the prior art in general (including the references of record) teach slot machine combinations to be either winning combinations or losing combinations. The winning combinations are rewarded with additional play credits or prizes, and the losing combinations are rewarded with nothing. Nothing in the prior art shows, teaches, or suggests a special combination of symbols to change play from a slot machine game to a pinball machine game, as required by claim 9.

In support of this argument, Applicants refer to the Notice of Allowance and Fees Due (dated December 17, 2003) issued in parent Pat. Appl. No. 09/988,794 in which allowable subject matter was described for that application. A copy of the Notice \* is enclosed for the Examiner's reference. At page 2 of the Notice, the Reasons for Allowance state "the prior art does not anticipate, nor make obvious, the combination of a slot machine and a pinball machine wherein either game can be played first and the combination further includes a means for automatically switching to the other machine when a pre-determined number of credits is won". The "pre-determined number of credits" referred to in this statement is a specific type of condition precedent for switching slot machine play to pinball machine play.

Applicants believe the **special combination of slot machine symbols** required by claim 9 for switching slot machine play to pinball machine play is an analogous condition. Thus, claim 9 should be allowed under the same reasoning. None of the references of record, including Wichinsky, show or suggest such a conditional requirement for switching play from a slot machine to a pinball machine.

For at least the foregoing reasons, Applicants believe claim 9 is patentable over the references of record, alone or in combination. Claims 10-16 depend either directly or indirectly from claim 9 and further describe the features of Applicants' gaming apparatus. They are submitted as patentable over the references of record, including Wichinsky, for the same reasons as stated for claim 9. The following reasons are submitted in further support of the patentability of claims 10 and 13-16.

Claim 10 requires that Applicants' gaming apparatus continue operating in the slot mode if a combination of symbols not including the pinball symbol is displayed. This emphasizes that play switches from the slot machine to the pinball machine only when the predetermined combination of symbols including the pinball symbol is achieved. If the predetermined orientation is not achieved, play continues in the slot mode. This feature is not shown or suggested in the references of record. For example, Wichinsky teaches a gaming machine in which play switches from the slot machine to the pinball-type machine after each and every play of the slot machine, regardless of whether a special combination of symbols is achieved.

Claim 13 requires the pinball machine of the gaming apparatus be constructed so that the player can act to keep the pinball in play to continue operation of the apparatus in the pinball mode. This feature emphasizes that playing the pinball machine is substantially under the control of the player and not preset by the machine. None of the references of record show or suggest a gaming apparatus comprising a slot machine and a pinball machine where continued pinball play depends on actions (i.e., pinball play) of the player. Wichinsky, for example, limits duration of play of his pinball-type game by limiting the number of pinballs to play or the time to play the pinballs.

Claim 14 requires the pinball machine of the gaming apparatus include traditional pinball machine components, including a play area, a pinball, and a flipper. The player uses

the flipper to keep the pinball within the play area during play of the pinball machine, and play ends when the player allows the pinball to leave the play area. Playing the pinball machine is highly interactive and potentially unlimited in duration (e.g., free of preset limitations on play). Play only ends when the player allows the pinball to leave the play area; keeping the pinball in the play area is substantially dependent on player skill.

None of the references of record show or suggest a gaming apparatus comprising a slot machine and a traditional pinball machine. Wichinsky, for example, discloses a pinball-type machine (not a traditional pinball machine), in which a player uses a shooter for one-time shooting of a pinball into a playfield to interact with sensors. After the single shot, the pinball returns to the shooter and play ends. In some cases, the player may be given more shots. But this depends on the play limitations programed into the machine (e.g., a predetermined number of pinballs, a time limit to play the pinballs, etc.). A flipper is not used to maintain the pinball in the playfield after each shot, and player interaction is limited to aiming the shooter. Once the pinball is shot, player interaction is nonexistent. It could be said that Wichinsky's pinball-type game is more a game of chance than a game of skill.

Wichinsky also discloses his gaming machine in a wagering environment (e.g., a casino) where game limitations are desirable to control how much a player can win and how many times a game can be played. This wagering environment must be considered when determining what Wichinsky shows and teaches. Preset game limitations are important parts of Wichinsky's machine, including both his slot machine (as is known in the art) and his pinball-type machine (as is not known in the art, but taught by Wichinsky). Applicants deviate from this by combining in claim 14 a slot machine and a traditional pinball machine without such

preset limitations. Wichinsky cannot be interpreted to teach this combination.

Claim 15 depends from claim 14 and further requires the pinball machine of Applicants' apparatus include a credit adding sensor and a credit subtracting sensor. The flipper is used to keep the pinball in the play area and to move it into contact with the pinball sensors to create a pinball credit score. When the player allows the pinball to leave the play area, play switches from the pinball machine to the slot machine and the pinball credit score is added to a slot credit score.

None of the references of record show or suggest an apparatus comprising a slot machine and a pinball machine where credits earned playing the pinball machine are subsequently added to total credits available for playing the slot machine. In Wichinsky, for example, no credits are earned playing the pinball-type machine. Instead, slot machine symbols are re-spun in attempts to change an existing symbol combination into a winning combination.

Claim 16 depends from claim 14 and requires the slot machine of Applicants' apparatus include a lever. Uniquely, the lever is used both to activate the slot machine to display different combinations of slot machine symbols and to launch the pinball into the play area of the pinball machine. The references of record fail to show or suggest a lever capable of operating both a slot machine and a pinball machine.

Claim 17 requires that operation of the pinball machine in the pinball mode not affect the combination of symbols displayed by the slot machine. In other words, pinball play cannot create winning combinations of slot machine symbols. None of the references of record show or suggest a gaming apparatus comprising a slot machine and a pinball machine with distinct play from each other. For example in Wichinsky's machine, playing the pinball-type machine alters an orientation of slot icons achieved in a previous play of the slot machine. It gives

the player a second chance to spin/move one or more slot icons to try to achieve a winning combination slot icons. Play on the pinball-type machine is not distinct from play on the slot machine, it is interrelated and outcome determinative.

B. Claims 18-22

New claim 18 is directed toward a gaming apparatus operable by a player and having a slot mode and a pinball mode. The apparatus comprises:

- (a) a slot machine capable of being activated by a player in the slot mode of the apparatus to display different combinations of symbols;
- (b) a pinball machine operable in the pinball mode for the player to play a pinball game, **the pinball machine including a play area, a pinball, and a flipper, the flipper being operable by the player to interactively move the pinball around the play area;**
- (c) an electromechanical mechanism for automatically switching between operation of the slot machine and operation of the pinball machine when the player **allows** the pinball to move out of the play area of the pinball machine.

The references of record, including Wichinsky, fail to show or suggest each and every feature of the gaming apparatus described in claim 18. None show or suggest the unique combination of a slot machine and a traditional pinball machine including a play area, a pinball, and a flipper. The player uses the flipper to keep the pinball within the play area during play of the pinball machine, and play ends when the player allows the pinball to leave the play area. Playing the pinball machine is highly interactive and under control of the player. Duration of play is potentially unlimited (e.g., free of preset limitations on play). Play ends only when the player allows the pinball to leave the play area (not when a preset condition indicates play should end); keeping the pinball in the play area is substantially dependent on player skill.

As previously stated, Wichinsky discloses a pinball-type machine (not a traditional pinball machine), in which a player uses a shooter for one-time shooting of a pinball into a playfield to interact with sensors. After the single shot, the pinball returns to the shooter and play ends. The player does not control when play ends, preset limitations of the machine do. In some cases, the player may be given more shots. But this depends on the play limitations programed into the machine (e.g., a predetermined number of pinballs, a time limit to play the pinballs, etc.). A flipper is not used to maintain the pinball in the playfield after each shot, and player interaction is limited to aiming the shooter. Once the pinball is shot, player interaction is nonexistent. It could be said that Wichinsky's pinball-type game is more a game of chance than a game of skill.

Wichinsky also discloses his gaming machine in a wagering environment (e.g., a casino) where game limitations are desirable to control how much a player can win and how many times a game can be played. This wagering environment must be considered when determining what Wichinsky shows and teaches. Preset game limitations are important parts of Wichinsky's machine, including both his slot machine (as is known in the art) and his pinball-type machine (as is not known in the art, but taught by Wichinsky). Applicants deviate from this by combining a slot machine and a traditional pinball machine without such preset limitations. Wichinsky cannot be interpreted to teach this combination in which gaming limitations are not considered.

For at least the foregoing reasons, claim 18 is submitted as patentable over the references of record. Claims 19-22, depending either directly and indirectly from claim 18, are submitted as patentable for the same reasons.

Claim 19 depends from claim 18 and requires the slot machine of Applicants' apparatus include a lever used both to activate the slot machine to display different combinations of slot machine symbols and to launch the pinball into the play area of

the pinball machine. The references of record fail to show or suggest a lever capable of operating both a slot machine and a pinball machine. This further supports patentability of claim 19.

Claim 20 depends from claim 18 and requires the pinball machine of Applicants' apparatus include a credit sensor and a pinball credit score. As the pinball moves around the play area of the pinball machine, it engages the credit sensor and creates the pinball credit score. Claim 21 depends from claim 20 and further requires the slot machine have a slot credit score to which the pinball credit score is added when operation of the pinball mode switches to operation of the slot mode. Claim 22 depends from claim 21 and still further requires the pinball machine include multiple credit sensors of which at least one is a credit adding sensor and at least one is a credit subtracting sensor. During operation of the pinball machine, a player may add to the pinball credit score by engaging the credit adding sensor and may subtract from the pinball credit score by engaging the credit subtracting sensor. The final pinball credit score, however, cannot be negative.

As stated with respect to claim 15, none of the references of record show or suggest a gaming apparatus comprising a slot machine and a pinball machine with the unique credit sensor features required by claims 20-22. None show or suggest an apparatus where credits can be earned playing the pinball machine and then subsequently added to total credits available for playing the slot machine. For example, Wichinsky teaches playing his pinball-type machine in attempt to re-spin slot machine symbols to change an existing symbol combination into a winning combination. There is no suggestion to award credits for pinball play and then allow the player to use those credits during slot machine play.

C. Claims 23 and 24

New claim 23 is directed toward a gaming apparatus operable by a player and having a slot mode and a pinball mode. The gaming apparatus comprises:

- (a) a slot machine capable of being activated by a player in the slot mode of the apparatus to display different combinations of symbols, the slot machine including a lever;
- (b) a pinball machine operable in the pinball mode for the player to play a pinball game;
- (c) the lever of the slot machine being operable by the player to activate the slot machine in the slot mode of the apparatus, the lever being further operable by the player to play the pinball game in the pinball mode of the apparatus..

Applicants do not believe the references of record, alone or in combination, including Wichinsky, show or suggest all of the features of claim 23. None show or suggest an apparatus comprising a slot machine and a pinball machine where a lever of the slot machine is used to operate both the slot machine and the pinball machine. Accordingly, claim 23 is submitted as patentable over the references of record.

Claim 24 depends from claim 23 and is submitted as patentable for the same reasons as stated for claim 23. In addition, claim 23 further requires the slot machine include a slot credit score created by playing the slot machine, and the pinball machine include a play area, a pinball, a flipper, a credit adding sensor, a credit subtracting sensor, and a pinball credit score. In the pinball mode of the apparatus, the slot lever is operable to launch the pinball into the play area and the flipper is operable to interactively move the pinball around the play area to engage the credit sensors to create the pinball credit score. The pinball credit score is added to the slot credit score when the pinball moves out of the play area of the pinball machine and the apparatus switches from the pinball mode to the slot mode.

As previously stated, none of the references of record, including Wichinsky, show or suggest an apparatus combining a slot machine and a pinball machine with traditional pinball machine components and where a slot machine lever can be used to launch a pinball into a play area of the pinball machine. In addition, none show or suggest an apparatus where credits can be earned playing the pinball machine and then subsequently added to total credits available for playing the slot machine. There is no suggestion in the prior art to award credits for pinball play and then allow the player to use those credits during slot machine play. Claim 24 is submitted as patentable for at least these additional reasons.

#### VII. Conclusion

In view of the foregoing remarks, favorable consideration and allowance of pending claims 9-24 is requested. Applicants hereby request an extension of time to and including April 14, 2005, for filing a response to the above-referenced December 14, 2004, Office action. Applicants enclose a check in the amount of \$60.00 in payment of the one month extension to respond to the Office action. The Commissioner is authorized to charge any underpayment of government fees to Deposit Account No. 19-1345.

Respectfully submitted,



Brian G. Panka, Reg. No. 53,430  
SENNIGER POWERS  
One Metropolitan Square, 16th Floor  
St. Louis, Missouri 63102  
(314) 231-5400

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